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REMARKS

Claims 39-43, 70 and 80-86 are in the case.

Applicants gratefully acknowledge the withdrawal of the objections to claims 41, 82, 84 and the withdrawal of the rejections of claims 82, 84, 86, and 43 under 35 USC § 112 2nd paragraph.

No new matter has been added.

All claims stand rejected variously under 35 USC §112 and §103.

Paragraph numbers used below correspond to those of the pending Office Action.

Claim Rejections – 35 USC § 112

4. Claims 39-43, 70 and 80-86 remain rejected under 35 USC § 112, first paragraph for lack of enablement. Applicants arguments filed 12 August 2004 have been found unpersuasive. The Examiner maintains his argument that the specification fails to teach that multiple SSR systems can be used together in the same plant and that the specification does not contain working examples that demonstrate the claimed methods. Applicants respectfully traverse.

The examiner maintains the specification is enabling only for the use of single site recombinase systems (SSR) but that multiple SSR are not taught so as to put the public in possession of the invention without undue experimentation.

Applicants submit that the specification enables the person of skill in the art to make and use the present invention comprising the use of multiple SSR systems in a single plant without undue experimentation.

The examiner suggests that Applicant has attempted to show the state of the art by offering the teachings of U.S. 6,262,341 ("Method for the integration of foreign DNA into eukaryotic genomes", Issued 20010717) and U.S. 6,541,231 ("Method for the integration of foreign DNA into eukaryotic genomes", Issued 20030401) in support of the present invention. Applicant notes that these references were not offered to show the state of the art but rather to demonstrate that undue experimentation was not needed as, after Applicants' disclosure and teaching of multiple SSR, these patents described a similar use. Thus, applicant submits that any experimentation was not undue as the person of skill in the art was clearly able to use the teachings of the present application to derive those of U.S. 6,262,341 and U.S. 6,541,231.

In view of the foregoing Applicant respectfully requests reconsideration of the claims and removal of this rejection.

Claim Rejections – 35 USC § 103

5. Pending Claims 39-41, 43, 70, 80, 81, 83 and 85 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Odell et al. "A" (*Mol. Gen. Genet.* 223: 369-378 (1990)),

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in combination with Lloyd et al. (*Mol. Gen. Genet.* 242: 653-657 (1994)), Applicants' admitted state of the prior art, and Odell et al. "B" (Use of Site-Specific Recombination Systems in Plants, in Homologous Recombination and Gene Silencing in Plants; Paszkowski, J., Ed.; Kluwer: Dordrecht, Germany, 1994; pp 219-270). The Examiner maintains that the cited references demonstrate that more than one site-specific recombinase system is active in plants, that the ability of site-specific recombinases to locate their target sites on individual chromosomes is quite impressive, and that one of ordinary skill in the art had a reasonable expectation of success that two different site-specific recombination systems can work in the same plant without interfering with each other.

Applicants again respectfully traverse the rejection and submit that this combination of references in no way teaches or suggests Applicants' invention, and therefore, fails to establish a *prima facie* case of obviousness.

Applicants note here that the Examiner's arguments under this section and 35 USC § 112, first paragraph appear inconsistent. The Examiner asserts that the state of the art teaching the use of single SSR's is sufficient to render the invention obvious, however under § 112 suggest that undue experimentation would be necessary to reduce the invention to practice based on the level of teaching in the specification. Applicants submit that if undue experimentation is needed then the invention cannot be obvious, whereas if the invention is obvious, and the skilled person had a reasonable expectation of success, then the skilled person by definition would not have to employ undue experimentation to derive the invention. Clarification is respectfully requested.

The teachings of the cited art have been given previously. The arguments made by Applicants previously in response to this rejection are relevant and are incorporated herein by reference.

Applicants suggest that the present invention is not obvious in view of the cited art, not only for reasons of record but also in view of the secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts which form the basis of a body of objective evidence that the examiner is required to consider (MEPE 2141).

The Examiner has not found the declaration of Odell, submitted under Rule 132, persuasive as Dr. Odell is not, in the view of the examiner, a disinterested party. However, although, Dr. Odell is currently employed by the patent assignee, such a fact is does not *a priori* render Dr. Odell a disinterested party. Additionally, it is well settled that, in the offering of opinion evidence, the interest or disinterest of the party offering the evidence cannot be disregarded for this reason alone. As stated in MPEP (716.01(b))

"An affidavit of an applicant as to the advantages of his or her claimed invention, while less persuasive than that of a disinterested person, cannot be

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disregarded for this reason alone. *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F.2d 717, 97 USPQ 348 (CCPA 1953). “

Thus Applicant submits that the declaration of Odell under Rule 132 is some evidence that the combination of multiple SSR in plants was unexpected, and was viewed with skepticism by an expert in the art of site specific recombination.

Additionally, the fact that other patents have now been filed exemplifying the use of multiple SSR is evidence of commercial success. Furthermore, the fact that, prior to Applicants' teaching in the present application, there has been no reported use of multiple SSR in plants, is evidence of the failure of others.

Hence Applicant reiterates that the present invention is not obvious over the cited art and respectfully request that the examiner consider these secondary considerations in combination with applicants' prior arguments and remove all rejections under 35 USC § 103.

Request for Interview

This response accompanies a Request for Continuing Examination under 37 CFR 1.114. In the event the Examiner does not find the above arguments persuasive and the claims allowable, Applicant respectfully requests an interview with the Examiner prior to the issuance of the first office action.

Additional Fees

Should there be any fee due not expressly authorized in connection with the filing of this Amendment or Request for Continuing Examination please charge such fee to Deposit Account No. 04-1928 (E. I. du Pont de Nemours and Company).

Respectfully submitted,



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